

Application Serial No. 10/652,261 - Filed August 29, 2003

**REMARKS**

Claims 1-23 are pending in the application.

Applicant notes and appreciates withdrawal of the previous rejections.

**Final Rejection was Premature**

Applicant respectfully requests that the Examiner withdraw the finality of the rejection mailed on April 6, 2006. Applicant contends that the final rejection was premature under section 706.07(a) of the MPEP, which states:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement... [emphasis added]

The Examiner states that the action is made final pursuant to MPEP 706.07(a) because "Applicant's amendment necessitated the new ground(s) of rejection." However, Applicant respectfully submits the amendment did not necessitate the new grounds of rejection.

In Applicant's Response dated February 14, 2006, Claim 10 was merely amended to correct a lack of antecedent basis for the term "client device", and corresponding amendments were made to each of claims 11-17. Examination of those amendments clearly reveal they did not necessitate the new grounds of rejection. No other claim amendments were made, including no amendments to each of independent claims 1, 18, or 20.

In the present Office Action, each of the independent claims has been rejected based upon a new basis. In particular, claims 1-2, 10, 16 and 20-21 stand rejected under

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35 U.S.C. § 102(e) as being anticipated by Turner (US 2002/0059608 A1, hereinafter "Turner"). Clearly, as no amendments were made to independent claims 1, 18 or 20, Applicant's amendment could not have necessitated the new ground of rejection currently applied to those claims. Further, Applicant believes it readily apparent that the amendment to claim 10 as discussed above in no way necessitated the new ground of rejection.

Thus, Applicant contends that the new grounds of rejection are not related to Applicant's amendment and were not necessitated by Applicant's amendment. Therefore, Applicant respectfully requests that the Examiner withdraw the finality of the present rejection.

#### Claim Rejections

In the present Office Action, claims 1-2, 10, 16 and 20-21 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Turner (US 2002/0059608 A1, hereinafter "Turner"). Applicant has carefully considered the examiner's new rejections and the cited art. However, Applicant believes the claims recite features neither disclosed nor suggested. Accordingly, Applicant traverses the above claim rejections and requests reconsideration in view of the following discussion.

In paragraph 3, pages 2-3 of the present Office Action, it is suggested that Turner discloses all of the features of claim 1. Specifically, it is suggested that

"[t]he claimed 'broadcasting a plurality of modules from a server to a plurality of client devices, at least one of said modules having an associated module number' is met by '[a] television system hereinafter described includes a broadcast receiver (called a set top box) for receiving digital data via terrestrial, cable or digital means, transmitted from a broadcaster at a remote location. The digital data results in a large number of channels [module numbers] and programs [modules] available for selection by a user' (Turner [0001]). . . . The claimed 'receiving the search criteria at the server and identifying a qualifying module number which

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corresponds to the search criteria' is met by '[t]he server 8 then searches EPG and/or closed caption databases 12 and 14 respectively for matches to the determined criteria. Programme information containing the matched criteria is cross referenced with EPG data to produce the resulting programme or programmes' (Turner [0026]) wherein the programme information includes the channel [module number] on which the programme [module] is to be shown (Turner [0028]). . . . The claimed 'retrieving a first module of said modules at the client device, in response to matching the received qualifying module number to said first module' is met by '[t]he results to the user's query can be displayed in a form that the user can browse and select programmes to watch and record' (Turner [0027]) wherein by selecting a program to be watched, a program [module] is retrieved by channel [module number]."

Applicant notes that the broadest reasonable interpretation of a claim term must be consistent with the interpretation that one of skill in the art would reach (see MPEP 2111). In effect, the Office Action appears to equate a program with a module, and a channel with a module number. Anticipation requires fairly strict identity (see MPEP 2131). While different terminology may be used, it must be clear that the terms have identical meaning. Applicant submits a module number as recited, and clearly described, is not equivalent to a channel.

As may be seen from claim 1, at least one module has an associated module number. The server identifies a qualifying module number which corresponds to the search criteria and sends the qualifying module number to the client device. The client device retrieves a first module of said modules, in response to matching the received qualifying module number to said first module. In contrast to the above, Turner discloses displaying electronic program guide (EPG) information matching a user's search criteria and from which the user may select a program to watch. Turner's EPG information "may include the name of a programme containing the requested information, the channel on which the programme is to be shown, the time of the programme, the length of the programme, a brief summary of what the programme is about and/or the like." (Turner [0028]). As may be appreciated, a channel may contain numerous programmes shown at different times, each of which may pertain to different subjects and be of different lengths. Users of Turner's system select programmes to watch and/or record based on

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EPG information. However, Turner does not teach or suggest that a programme is retrieved in response to matching a channel to a programme. Although Turner discloses that EPG information may include channel information, Turner is silent as to which parts of the EPG information are used to select a programme. Even though a user of Turner's system might be able to match a channel to a programme, Turner does not disclose such a step as part of programme selection, nor would identifying the channel on which the programme is to be shown be sufficient to allow a programme to be retrieved without additional information such as the time and length of the programme. Accordingly, Applicant finds no teaching or suggestion in Turner of *"retrieving a first module of said modules at the client device, in response to matching the received qualifying module number to said first module,"* as is recited in claim 1.

For at least these reasons, Applicant submits that claim 1 is patentably distinguished from Turner. In addition, as each of independent claims 10, 16, 18 and 20 include similar features, each of these claims is believed patentably distinguished for similar reasons.

In addition to the above, claims 3, 6-7, 11, 14, 17-18, and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Turner (US 2002/0059608 A1) in further view of Dunn (U.S. Patent 6,668,377 B1, hereinafter "Dunn"). Applicant respectfully traverses these rejections and requests reconsideration in view of the following discussion.

Claim 3 recites a claim which includes:

"a viewer generating a video request based upon said displayed information, said video being associated with said first module;  
sending said video request to said server; and  
sending a video corresponding to said video request from the server to the client device."

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Regarding claim 3, in paragraph 5, pages 7-8 of the present Office Action, it is stated that "the Turner reference is silent as to requesting video from a server," but that the combination of Turner and Dunn discloses the features of claim 3. In particular, it is suggested on page 8 that "The claimed 'said video being associated with said first module' is met by the Turner and Dunn combination . . . wherein the requested program is associated with the previews. (Dunn 12:66-13:10)." Applicant respectfully submits that the combination of Dunn and Turner does not disclose all the features of claim 3.

It is first noted that Dunn merely discloses a video-on-demand system in which previews of available videos are displayed from which a viewer may select an associated program to be ordered. More specifically, Dunn discloses:

"When the STB tunes to the VOD channel, a continuous loop of "new releases" trailers are immediately displayed. These trailers are a predefined group of about 20-40 of the newest video programs that are presently available for rent. The trailers are displayed in a sequential fashion, one after another, to entice a viewer to stay on the VOD channel, watch more previews, and ultimately order a program." (Dunn, col. 6, lines 58-65)

"The default set of "new releases" trailers are shown. If the viewer remains passive, the "new releases" trailers will run in a continuous loop, one after another. If the viewer wishes to select a new group of programs, the viewer can actuate the "choices" button 78 to pull up various lists of criteria (e.g., star name, title, viewer list, etc.). From the one or more lists, the viewer actively specifies a criteria to select a group of programs (step 222). The criteria is transmitted from the STB to the headend (step 224).

At the headend, a search of the SQL database is conducted to locate program records which meet the search criteria (step 226). . . . At step 228, the set of program records that meet the criteria are sent back to the requesting STB." (Dunn, col. 12, lines 22-38).

"At step 230, the viewer actuates the "preview" icon button 142 (FIGS. 5 and 9) to request play of the first preview video trailer in the program set. This request is sent to headend, which begins transmitting the preview of the first trailer in the group in response (step 232)." (Dunn, col. 12, lines 41-51).

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From the above excerpts it can be seen that Dunn discloses an STB tunes to the VOD channel and default previews are displayed. A viewer then may send specific criteria (e.g., a star name) to the headend to be matched to specific programs and trailers. The headend responds with a set of matches. The STB may then request a preview of one of the matches. The request is transmitted to the headend, which then transmits the first preview to the STB in response to the request. Having viewed the previews, the viewer may ultimately order a program.

In contrast to the teachings of Dunn, the first module as recited in claim 1 is (1) not broadcast responsive to a client request and (2) matches a received qualifying module number, which corresponds to the search criteria. In order for Dunn's requested program being associated with the previews to be equivalent to the recited "video being associated with said first module," as suggested, one of Dunn's previews would have to be equivalent to the first module. However, Dunn's previews are either from a default set and hence not corresponding to the search criteria, or non-default and hence broadcast in response to a client request. Therefore, Dunn's previews are not equivalent to the claimed qualifying modules.

Combining Dunn with Turner may produce a system in which the server responds to search criteria with program records that match the criteria and correspond to previews. However, these previews are not broadcast unless the viewer requests them. Thus, Dunn's non-default previews, used in the system of Turner, are not equivalent to the recited first module. Therefore, despite Dunn's disclosure of a requested program being associated with the previews, the requested program is not associated with a preview that is both non-requested and that matches the search criteria even when combined with the teachings of Turner. Accordingly, Applicant finds no teaching or suggestion in the cited art, either singly or in combination, of "a viewer generating a video request based upon said displayed information, said video being associated with said first module," as is recited in claim 3.

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For at least these reasons, Applicant submits that claim 3 is patentably distinguished from the cited art. In addition, as claims 11, 17, 18, and 22 include similar features, claims 11, 17, 18, and 22 are believed patentably distinguished for similar reasons.

Applicant further notes on pages 13-17 of the present Office Action, additional rejections are made of dependent claims under 35 U.S.C. § 103(a). However, each of these additional rejections depends upon either Turner or Turner and Dunn as discussed above. As each of the claims are patentable for at least the reasons given above, further discussion of the features of these claims is believed unnecessary at this time. Further, as each of the dependent claims includes at least the features of the claims upon which they depend, each of dependent claims are believed patentable for at least the reasons given above as well.

Should the examiner still believe there is reason to prevent the present application from proceeding to allowance, the below signed representative would greatly appreciate a telephone call at (512) 853-8866 in order to facilitate a more rapid resolution.

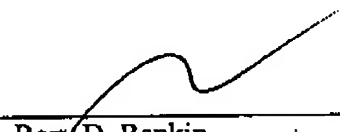
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**CONCLUSION**

Applicant submits the application is in condition for allowance, and an early notice to that effect is requested.

If any extensions of time (under 37 C.F.R. § 1.136) are necessary to prevent the above referenced application from becoming abandoned, Applicant hereby petitions for such extensions. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5266-08801/RDR.

Respectfully submitted,



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Rory D. Rankin  
Reg. No. 47,884  
ATTORNEY FOR APPLICANT(S)

Meyertons, Hood, Kivlin,  
Kowert, & Goetzel, P.C.  
P.O. Box 398  
Austin, TX 78767-0398  
Phone: (512) 853-8800

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